

amended in the response to the previous office action and, previous to that, the amendment made to claim 1 was merely of a clerical nature. The Examiner's introduction of a new ground of rejection that is neither necessitated by applicant's amendment of the claims, nor based on information submitted in a suitably filed information disclosure statement, makes finality of the action improper and contrary to MPEP 706.06(a). Therefore, and in accordance with MPEP 706.07(d), the applicant respectfully requests that finality of the action be withdrawn.

II. Piecemeal examination

As mentioned above, claim 1 was not amended in the response to the previous office action and, previous to that, the amendment was one of form and not substance. As such, if the Examiner contends that the present ground of rejection (namely, the combination of Jonsson and Bernstein under 35 USC 103) is better suited to rejecting the very same claim that was rejected last time on a different ground (namely, Jonsson under 35 USC 103) and prior to that on yet another ground (namely, Bernstein under 35 USC 102), then, with respect, it would appear that the Examiner is conducting piecemeal examination. This is contrary to MPEP¹ 707.07(g) and therefore the applicant respectfully requests that finality of the action be withdrawn.

B. REPLY TO REJECTION UNDER 35 USC 103

On page 2 of the Office Action, the Examiner rejects claims 1-24, 27, 30-32 and 34-40 under 35 USC 103(a) as being unpatentable over Jonsson et al. (U.S. Patent 5,513,246, hereinafter referred to as "Jonsson"), in view of Bernstein et al. (U.S. Patent 6,574,203, hereinafter referred to as "Bernstein"). In response, the applicant disagrees and traverses the rejection.

¹ Manual of Patent Examining Procedure 8th edition

Independent Claim 1

I. Insufficient basis for obviousness rejection

On page 4 of the Office Action, the Examiner states "It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Jonsson et al. with Bernstein et al. to obtain the invention as specified, for handover process from first frequency to second frequency."²

However, as outlined in MPEP 706.02(j), quoting from *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985): "[t]o support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references."

This is further expressed in the MPEP's own guidelines as follows (see MPEP 706.02(j)):

"After indicating that the rejection is under 35 U.S.C. 103, the examiner should set forth in the Office action:

[...]

(D) an explanation as to why the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made."

² It should be noted that the inquiry into whether the "handover process from first frequency to second frequency" is obvious is inconsequential, since the claim deals with the opposite effect, namely wherein the subscriber station switches from the second mode to the first mode.

Indeed, the Supreme Court held similarly in *KSR International Co. v. Teleflex Inc.*, 550 USPQ2d 1385 (2007), quoting from *In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006): “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”

With respect, the Examiner’s contention that claim 1 is obvious contains no such “explanation”, “articulated reasoning” or “convincing line of reasoning”. Rather, it appears to contain statements which, by their “mere conclusory” nature, would seem to lack the established jurisprudential prerequisites for a rejection under obviousness. Therefore, the applicant respectfully requests that the rejection of claim 1 under 35 USC 103 be withdrawn.

II. Missing element from combination of references

One of the main difficulties encountered by the applicant when reviewing the Examiner’s previous rejections was disagreement as to interpretation of the prior art’s teaching of a handoff signal. On page 8 of the most recent Office Action, the Examiner responds to the applicant’s remarks made in the previous response by equating the claimed “handoff signal” to the “alarm” in Jonsson. With respect, this comparison, regardless of its accuracy, does not allow the Examiner to sustain an obviousness rejection.

To be specific, and as alluded to in previous responses, one of Jonsson’s principal defects is that Jonsson does not teach or suggest a converter for translating any signal – let alone a handoff signal – from a first mode to a second mode. Therefore, even if it were true that Jonsson’s “alarm” corresponds to the claimed “handoff signal”, it does not change the fact that Jonsson still does not “translate” the handoff signal (or the alarm) from one mode to another.

In order to assist the Examiner in understanding the role behind the converter and the translating of the handoff signal, let us consider the effect of translating the handoff signal from the "first mode" to the "second mode". Specifically, consider a pre-handoff base station that communicates with subscriber stations in the second mode, and a post-handoff base station (i.e., the claimed device) that communicates with subscriber stations in the first mode. Consider now a particular subscriber station that is being serviced by the pre-handoff base station (i.e., in the second mode) and which enters an area that intersects the coverage areas serviced by the pre-handoff base station (in the second mode) and the post-handoff base station (in the first mode).

In a prior art solution, the pre-handoff base station (which, it is recalled, operates in the second mode) makes a handoff decision and triggers handoff by communicating with the particular subscriber station. Such communication occurs in the second mode, and tells the particular subscriber station to switch over to the first mode and communicate thereafter with the post-handoff base station in the first mode. The pre-handoff base station then leaves matters in the hands of the post-handoff base station, which may or may not actually be ready to accept communication with the particular subscriber station.

In contrast, consider now the unconventional scenario where it is desired that the post-handoff base station (which, it is recalled, operates in the **first mode**) trigger handoff by generating a handoff signal. A potential problem arises, however, because the handoff signal will be generated by the post-handoff base station in the first mode but the particular subscriber station is still communicating with the pre-handoff base station in the second mode. To solve this potential problem, the post-handoff base station needs to translate the handoff signal from the first mode to the second mode so that it is properly received by the particular subscriber station. Accordingly, there is a need for a specialized device in the post-handoff base station (i.e., the device claimed in claim 1) that receives the handoff signal in the first mode and incorporates "a converter [...] for translating

the handoff signal from the first mode into the second mode; the second mode handoff signal for indicating to [the particular] subscriber station operating in the second mode within both of the coverage areas to switch from the second mode to the first mode so that the [particular] subscriber station operates in the first mode."

The signal translation provided by the presently claimed converter and device allows the handoff signal from the post-handoff base station, which normally operates in the first mode, to nevertheless be issued in the second mode. In this way, the handoff signal "infiltrates" the subscriber station which has been meanwhile communicating with the pre-handoff base station in the second mode. The "infiltrated" handoff signal changes the operating mode of the subscriber station (switching it to the first mode) and figuratively "pulls" the subscriber station towards the post-handoff base station.

The triggering of handoff by the post-handoff base station (and particularly, the need or usefulness of "a converter [to] translate[e] the handoff signal from the first mode into the second mode") is simply not contemplated in the cited art. Specifically, in Jonsson, there is no detail about the handover process, just that it occurs (step S25). If any one base station triggers handover in Jonsson, it is the very base station with which the subscriber station was communicating prior to handover, namely the pre-handover base station. There is hence no need for a "converter" to "translate[e]" any handoff signal from one mode to another.

As for Bernstein, the decision to change operating states is carried out exclusively by the subscriber station, so "handoff" cannot be said to be triggered by the post-handoff base station (nor by the pre-handoff base station, for that matter...). As such, Bernstein's teachings completely fail to teach the claimed "converter" and "translation" that are missing from Jonsson but present in the claim.

It should therefore be apparent that at least one feature of claim 1 is still missing from the combination of Jonsson and Bernstein.

In light of the foregoing, it should be apparent that the Examiner's argument is at odds with both prongs of the obviousness inquiry in the aforesaid citation of *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985), quoted in MPEP 706.02(j): "[t]o support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." (emphasis added).

The Examiner is therefore respectfully requested to withdraw the 35 USC 103 rejection of claim 1.

Independent Claims 10, 17, 27 and 30

Each of these claims includes features similar to those of independent claim 1 and therefore the same arguments as those set forth in support of claim 1 also apply to these claims. The Examiner is therefore respectfully requested to withdraw the 35 USC 103 rejection of claims 10, 17, 27 and 30.

Dependent Claims 2-7, 11-16, 18-24, 31-32 and 34-40

Each of these claims is dependent on one of independent claims 1, 10, 17, 27 and 30, and therefore incorporates by reference all of the features of the respective base claim. As such, the above arguments that support a finding of non-obviousness of the independent claims also apply to dependent claims 2-7, 11-16, 18-24, 31-32 and 34-40. The Examiner is therefore respectfully requested to withdraw the 35 USC 103 rejection of claims 2-7, 11-16, 18-24, 31-32 and 34-40.

Dependent Claims 8-9

Each of these claims is dependent on independent claim 1 and therefore incorporates by reference all of the features of claim 1. As such, the above arguments that support a finding of non-obviousness of claim 1 also apply to dependent claims 8-9.

Furthermore, the Examiner refers to a third reference, "Chang", without explaining to any degree the perceived relevance of this new reference. Thus, with respect, the Examiner's obviousness rejection is not in alignment with MPEP 706.02(j), which reads, in part:

"After indicating that the rejection is under 35 U.S.C. 103, the examiner should set forth in the Office action:

(A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate [...]"

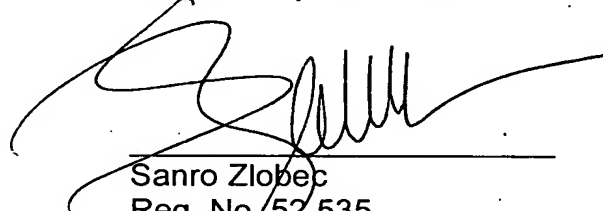
For the above reasons, the Examiner is therefore respectfully requested to withdraw the 35 USC 103 rejection of claims 8-9.

CONCLUSION

In view of the foregoing, the applicant is of the view that claims 1-24, 27, 30-32 and 34-40 are in condition for allowance. Favorable reconsideration is requested. Early allowance is solicited.

If the application is not considered to be in full condition for allowance, for any reason, the Examiner is respectfully requested to contact the applicant's agent at the below coordinates to discuss any remaining issues with a view to expediting the prosecution of this application and avoiding the need for further proceedings.

Respectfully submitted,



Sanro Zlobec
Reg. No. 52,535
Agent for the Applicants

Date: June 18, 2008

SMART & BIGGAR
1000 De La Gauchetière Street West
Suite 3300
Montreal, Quebec H3B 4W5
CANADA

Telephone : (514) 954-1500
Fascimile : (514) 954-1396